

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Dante E. PICCONE

Original Patent No.: 5,614,737

Patent No.: RE36770

Original Issue Date: March 25, 1997

Reissued: July 11, 2000

Application No.: 09/273,567

For: MOS-CONTROLLED HIGH-POWER
THYRISTOR

Filed: March 22, 1999

**STATEMENT BY PETER S. WEISSMAN IN SUPPORT OF PETITION FOR
RECONSIDERATION UNDER 37 C.F.R. § 1.378(B)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of a Petition for Reconsideration under 37 C.F.R. § 1.378(b) ("Petition").

The undersigned hereby states that:

1. I am a partner at the law firm of Blank Rome LLP ("the firm"). I have been employed by the firm as an attorney for approximately 10 years.

2. Sometime in 2009, the firm received an application for employment from Huedell George. Mr. George submitted a curriculum vitae with his application. A copy of that curriculum vitae is attached here as Exhibit A.

3. The week of February 17, 2010, I contacted Mr. George by telephone to discuss having him sign a statement in support of the Petition to Revive the above-identified patent.

4. During that initial telephone conference, Mr. George indicated that he would be willing to execute a statement. Mr. George told me the following:

a. He confirmed that he served as a consultant to the docketing department of the law firm of Blank Rome LLP from December 1999 to June 2001, though "IP Staffing, Inc.," as set forth in his curriculum vitae (Exhibit A). Before working for the firm, he had approximately 5 ½ years of docketing experience, including Docketing Supervisor at Rothwell Figg Ernst & Manbeck PC, and Intellectual Property Specialist for Mobil Oil Corporation.

b. During my tenure at the firm, Linda Bynum-Cosby was the head of the Docketing Department, and I worked directly for Ms. Cosby. Ms. Cosby was very knowledgeable about the patent process, patent docketing procedures and was very competent in her job. In addition, Ms. Cosby was very detail-oriented in docketing each and every case. Accordingly, it is my opinion that Ms. Cosby was reliable, and that the firm reasonable and exercised due care to protect its most important business, including the present patent, by entrusting Ms. Cosby as its head of the docketing department.

c. One of the projects I was tasked with performing, was to conduct a comprehensive integrity review of all existing, new and transfer patent files, both international and domestic. The purpose of the review was to confirm that the firm's cases were properly docketed in the firm's docketing software. I reviewed each file given to me to ensure that it was properly docketed in the firm's docketing software. Whenever I noted an issue, I would correct the docketing software entry, print a copy of the docket report, highlight the changed data, and present the file and docket report to Ms. Cosby. Most of the issues I noted were relatively minor and I do not recall identifying any major issues.

d. In addition to the integrity review, my other responsibilities included to docket and review PTO foreign and domestic mail correspondence, facsimiles and e-mail;

perform integrity review and maintenance of all existing, new and transfer client/matter based case files and computerized record information; assist in the review and processing of all incoming national and international mail and packages via U.S. Postal Office, Federal Express, UPS and other courier services; inspect, assemble, record and submit applications for PTO registration consideration, while ensuring specific formalities and procedures were followed and in accordance with the PTO regulations; and trained docket clerks as needed; respond to special requests, problem solving and trouble shooting inquiries.

e. He confirmed the firm procedures for docketing maintenance fees as set forth in the Statement of SueAnne Gill.

5. Based on the information provided to me by Mr. George, I prepared a Statement for him to sign. A copy of the Statement is attached hereto as Exhibit B.

6. On February 25, 2010, I sent the Statement to him for review and signature. A copy of the e-mail is attached hereto as Exhibit C.


6. I have left several telephone messages for Mr. George, and sent him email reminders on March 8 and April 9, 2010 (see Exhibit C). However, Mr. George has not responded to me, and has not returned a signed Statement.

Dated:

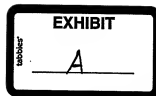
June 8, 2010

Respectfully,

By:


Peter S. Weissman
Reg. No. 40,220

REDACTED



EXPERIENCE REDACTED

IP Supervisor, June 2006 – Present

Responsibilities include but are not limited to the following:

- Manage the day to day operations of the Docketing and Formalities departments; staff performance, training initiatives, workflow and productivity, team building initiatives, problem solving; staff leave, work schedule, overtime approvals and policies and procedures reinforcement.
- Evaluate, develop and implement strategies, procedures and processes to enhance overall efficiency and productivity.
- Assist IP Manager with business development, best practice initiatives and client service support to members of the IP practice group.
- Provide mentorship/training to the Docketing and Formalities Coordinators to enhance their responsibilities and leadership attributes.
- Maintain current MPEP and CFR patent and trademark guidelines.
- Oversee transfer projects; intake, case file and system integrity review, system update/maintenance (manual or electronic upload), report generation, file closing/exit process.
- Prepare staff performance evaluations and conduct meetings (90 day probation and yearly).
- Prepare specialized client spreadsheet and portfolio reports.
- Conduct perspective new hire interviews.
- Assist Records Management with document and record retention initiatives.
- Responsive to all other special requests and inquiries as needed.

REDACTED

Case Manager/Docket Specialist, June 2001 – June 2006

- Managed/coordinated WaveCrest Laboratories LLC entire patent applications portfolio.
- Reviewed, organized, prepared WaveCrest applications for Patent consideration, while ensuring specific formalities and procedures were followed in accordance with the USPTO guidelines and regulations.
- Coordinated foreign application priority filings, PCT direct and national phase filings; forwarded executed formal documents to foreign agents.
- Ordered certified copies from the USPTO, formal drawings; prepared formal documents (i.e., power of attorney, assignment and agreement); forwarded formal documents to client for signature.
- Prepared responses to missing parts of non-provisional applications, assignment recordal, information disclosure statements.
- Assisted attorney/agent with office action responses - amendment prep etc..
- Managed daily time entry in DTE with regards to client matter billing.
- Docketed and processed patent foreign and domestic mail, facsimile and e-mail correspondence in the IPMS computer docketing and record management system; maintain manual calendar docket.
- Distributed updated daily, bi-weekly and monthly patent dockets, as well as various case status reports in Word or Excel chart format for clients and attorneys as needed.
- Performed integrity review of all existing, new and transfer case files as well as prepare transition status chart.
- Inspected, assembled, recorded USPTO filings; scheduled courier pickup through LaserShip courier service.
- Trained staff on procedures and processes as needed.
- Responded to all special requests, problem solving and trouble shooting inquiries.

Blank Rome Comisky and McCauley LLP, Washington, DC

Intellectual Property Specialist - Consultant, December 1999 - June 2001

- Docketed and reviewed Patent and Trademark foreign and domestic mail correspondence, facsimile and e-mail.
- Performed integrity review and maintenance of all existing, new and transfer client/matter based case files and computerized record information.
- Assisted in the reviewing and processing of all incoming national and international mail and packages via US Postal Office, Federal Express, UPS and various other courier services.
- Inspected, assembled, recorded, and submitted applications for Patent and Trademark Registration consideration, while ensuring specific formalities and procedures were followed and were in accordance with the USPTO regulations.
- Trained docket clerks as needed.
- Responsive to special requests, problem solving and trouble shooting inquiries.

REDACTED

Intellectual Property Specialist, November 1997- May 2000

- Responsible for docketing, maintenance, and updating Mobil's 25,000 + pending foreign and domestic intellectual property case matters.
- Mastered computerized docketing system (CPI) to create and generate various status reports and queries on patented and pending applications for clients, attorneys, and other Specialists'.
- Instructed and supervised Specialists' on the use of the CPI patent docketing system, 37 CFR. guidelines and the creation of tailored client data reports.
- Devised a system to assign patent information and new case docket numbers.
- Reviewed and processed all incoming foreign and domestic mail and facsimiles.
- Inspected, assembled, recorded, and mailed documents to the USPTO for patent consideration.
- Corresponded regularly with outside counsel to expedite case matters while updating Mobil's computerized patent docketing system.
- Performed administrative duties consisting of records' management, proofreading documents, file integrity review; prepared letters and distributed correspondence.

REDACTED

Docketing Supervisor, March 1994 - November 1997

- Reviewed and docketed all client based foreign and domestic patent and trademark, intellectual property work as well as litigation.
- Provided daily, weekly and monthly docket updates and status reports for clients and attorneys.
- Assigned "matter" numbers to new cases and processed all incoming mail and facsimiles.
- Trained and supervised new and existing docket clerks in accordance with firm/CFR guidelines.
- Inspected, assembled, recorded, and submitted all document filings to USPTO.
- Performed research, ordering, and retrieval services for patents, local court documents, file histories, trademarks, and publications.
- Scheduled and performed courier services to USPTO, State Department, local district courts, foreign embassies, etc.

REDACTED

Docket No.: 105773.0132
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Dante E. PICCONE

Original Patent No.: 5,614,737

Patent No.: RE36770

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Reissued: July 11, 2000

Application No.: 09/273,567

For: MOS-CONTROLLED HIGH-POWER
THYRISTOR

Filed: March 22, 1999

**STATEMENT BY HUEDELL GEORGE JR. IN
SUPPORT OF PETITION TO REINSTATE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of a petition to reinstate the above-mentioned patent for failure to pay a maintenance fee. The undersigned hereby states that:

1. A copy of my curriculum vitae is attached here as Exhibit A. I served as a consultant to the docketing department of the law firm of Blank Rome LLP ("the firm") from December 1999 to June 2001, though "IP Staffing, Inc.." Before working for the firm, I had approximately 5 ½ years of docketing experience, including Docketing Supervisor at Rothwell Figg Ernst & Manbeck PC, and Intellectual Property Specialist for Mobil Oil Corporation.

2. My responsibilities included to docket and review PTO foreign and domestic mail correspondence, facsimiles and e-mail; perform integrity review and maintenance of all existing, new and transfer client/matter based case files and computerized record information; assist in the review and processing of all incoming national and international mail and packages via U.S. Postal Office, Federal Express, UPS and other courier services; inspect, assemble, record and submit applications for PTO registration consideration, while ensuring specific formalities and procedures were followed and in accordance with the PTO regulations; and trained docket clerks as needed; respond to special requests, problem solving and trouble shooting inquiries.

3. During my tenure at the firm, Linda Bynum-Cosby was the head of the Docketing Department, and I worked directly for Ms. Cosby. Ms. Cosby was very knowledgeable about the patent process, patent docketing procedures and was very competent in her job. In addition, Ms. Cosby was very detail-oriented in docketing each and every case. Accordingly, it is my opinion that Ms. Cosby was reliable, and that the firm reasonable and exercised due care to protect its most important business, including the present patent, by entrusting Ms. Cosby as its head of the docketing department.

4. One project I was tasked with performing, was to conduct a comprehensive integrity review of all existing, new and transfer patent files, both international and domestic. The purpose of the review was to confirm that the firm's cases were properly docketed in the firm's docketing software. Whenever I noted an issue, I would correct the docketing software entry, print a copy of the docket report, highlight the changed data, and present the file and docket report to Ms. Cosby.

5. At the time, the firm's system for attending to the payment of maintenance fees operated as follows. The firm used Thomson Master Data Center's IPMaster™ docketing software to maintain its case records and track due dates. When the firm first received an official notice of a grant date and patent number, normally upon receipt of the official Issue Notification, a docketing clerk was responsible for entering this information into the case record in the grant date field.

6. The firm's system included a software add-on maintenance fee program developed by Mind's Eye Development, which interfaced with the basic docketing software. The module containing this add-on software provided a maintenance fee clerk with an independent tracking mechanism for maintenance fees, as well as for generating client reminder and instruction acknowledgement letters.

7. Any post-issue communications mailed by the Office, for example, Maintenance Fee Reminders and Notices of Patent Expiration, were noted in the IPMaster™ software. Upon receipt of a Notice of Non-Acceptance of Payment, a response due date would be docketed in the "actions" tab of the software.

8. All of the above entries, were revisited and reconfirmed upon receipt of an original Letters Patent. Based upon my experience, the docketing aspects of the firm's maintenance fee payment system were sound, reliable, trustworthy, securely redundant, effective, reasonable, and the exercise of due care to be relied upon to track the firm's most important business.

9. It was not the firm's practice to docket status checks for maintenance fee statements and deposit account activity for maintenance fees believed to be paid on time. Rather, under the firm's system, anomalies, inconsistencies, questions and the like were to be resolved prior to taking action, but the docket record indications in general were to be reconciled with the maintenance fee files as soon as possible and definitely before any due date was cleared from the docket.

10. To secure this safeguard, I was required to make sure that the Docketing Department was in possession of the client's instructions required to clear the docket so that the maintenance fee file information would be added to the electronic file record to ensure the docket was cleared based on a complete and correct record, with any discrepancies having been resolved and removed expeditiously.

11. At the time of my employment, separate maintenance fee files were kept in addition to the firm's main prosecution files in order to streamline and simplify the maintenance fee tracking and payment process and its associated recordkeeping. All and only maintenance-fee-related documents were kept in those files. Also, unlike the firm's general prosecution files, maintenance fee files were created, maintained and stored by and in the maintenance fee clerk's file cabinets. All firm maintenance fee clerks were therefore intimately familiar with these files and aware that reference to them is essential for any information and instructions relating to maintenance fee payment (or nonpayment) in any given case.

12. Based on my IP experience, the above-described procedures were sufficient to docket and monitor maintenance fee due dates and payments and employment of additional safeguards were not required. Moreover, it is my opinion that the software and docketing procedures were reliable and trustworthy to track relevant deadlines including the deadline to pay maintenance fees. The above shows that the firm established and maintained reasonable safeguards to ensure that the maintenance fee clerks had ready access to all pertinent information in the payment of maintenance fees and that the firm took all reasonable precautions to ensure that the maintenance fees would be timely paid. Accordingly, it is my opinion that there was in place a business routine for performing the clerical function of paying maintenance fees, and that the business routine could be relied upon to avoid errors in its performance, and was reliable and trustworthy for the firm's most important business, including the present patent.

13. Based on my review of the documents, which are attached as Exhibits A-F to this Statement, two errors led to an unavoidable delay in the 3.5 year and 7.5 year maintenance fee

payments of the subject patent and occurred during the period of my employment. The first error occurred sometime in 2000 during the process of docketing maintenance fees. The second error occurred sometime in 2004 when the first error was discovered and corrected, but the maintenance fee record was not properly reviewed. A chronology of the events described hereinbelow is attached as Exhibit A.

14. In the present case, a first error occurred in that the 3.5 year maintenance fee was not docketed properly. As noted above, it was standard practice to enter the patent grant date into Thomson Master Data Center's IPMaster™ for calculation of maintenance fee due dates upon receipt of an Issue Notification. The Issue Notification for the subject patent was received on June 28, 2000. However, the Issue Notification was not properly processed. Based upon my review of the documents, it appears that it was not noted during the docketing of the maintenance fees that the subject patent was a reissue patent, and the docketing entry at the time of receiving the Reissue Notification mistakenly changed the year (but not the month and day) to that of the Reissue. Consequently, the 3.5 year maintenance fee was erroneously docketed for September 25, 2004 (instead of September 25, 2000), *i.e.*, based on the year of the reissue patent rather than the issue year of the original patent. (The month and day of the erroneous date were correctly based on the original patent.) A copy of the Issue Notification with the Blank Rome "Docketing" stamp contains a notation indicating that maintenance fees were docketed for these dates is attached hereto as Exhibit B. As indicated on the Issue Notification, the 3.5 year, 7.5 year and 11.5 year maintenance fees were erroneously docketed for September 25, 2004, September 25, 2008, and September 25, 2012, respectively (rather than September 25, 2000, September 25, 2004 and September 25, 2008).

15. That erroneous docket entry was made by Ms. Cosby, as confirmed by her handwritten initials "LBC" on the docketing notation made on Exhibit B. It is my opinion that this error is understandable, even for the firm's most important business, since at the time of the docket entry (November 2000), the correct 3.5 year deadline (September 25, 2000) had already passed (though the 4-year deadline had not). In addition, it should be recognized that Reissue and Reexamination proceedings are rather rare, and the PTO procedures are complicated and different than for normal utility patents. Had this been a normal utility patent, and not a reissue patent, it is unlikely that any error would have occurred.

16. Due to the errors in docketing, the correct 3.5 year maintenance fee due date was not entered into the docketing and maintenance fee software and the software did not generate a

reminder in advance of the correct 3.5 year (September 25, 2000) due date or the 4 year (March 25, 2001) maintenance fee grace deadline. Consequently, the docketed deadline was September 25, 2004, for the 3.5 year maintenance fee, which was three years after the actual deadline of March 25, 2001 (including the six-month grace period). As a result of this clerical error in entering the base date for maintenance fee due date calculation, the 3.5 year maintenance fee was not paid and the maintenance fee clerk and docketing staff were not alerted to the failure to make a payment.

17. Apparently, as the erroneous September 25, 2004, deadline drew near, the error in docketing maintenance fee due dates was noted and corrected as part of the firm's procedures to note any issues prior to taking action. Thus, the docket record for the patent currently identifies correct maintenance fee due dates. A copy of the docket record is attached hereto as Exhibit C. It is my understanding that, due to limitations in the docketing and maintenance fee software, it is not possible to identify the specific employee and date on which the error was noted and corrected.

18. Believing the patent to be in force based on the firm's docketing and maintenance fee records, a maintenance fee due date reminder was forwarded to the client on June 18, 2004 by the Maintenance Fee Clerk at the time. (Ex. D.) The reminder (Exhibit D) indicated that the "Year 8 Tax" was due September 25, 2004. That date is automatically retrieved from the docketing software and reflects the docket and maintenance fee record at the time. Thus, the error in docketing the 3.5 year maintenance fee due date was noted and corrected sometime prior to June 18, 2004.

19. It is my opinion that the person who noticed the erroneous deadline concluded that IPMaster merely indicated that the wrong fee was due – i.e., the 3.5 year fee, rather than the 7.5 year fee. It is important to note that the docketed date itself was correct (i.e., Sept. 25, 2004). It was only the indication that the "3.5 year fee" (rather than the "7.5 year fee") was due, which was incorrect. Given such an unusual situation, it is certainly understandable that the person would not have recognized at that time, that the earlier fee had not been paid, even though it is my opinion that the firm had a reliable and trustworthy system and personnel in place for the firm's most important business. In addition, the PTO confirmed receipt of the 7.5 year fee (see the PTO stamped post card at Exhibit E, 2nd page thereto), and the firm never received any notice from the PTO that the 7.5 year fee was not accepted. Once the PTO stamped postcard is

noted by the Maintenance Fee clerk, it is placed in the file and no further action is taken until the next maintenance fee reminder letter comes due.

20. However, a second error occurred when the first clerical error was noted and corrected. Specifically, the second clerical error was the failure to note that the 3.5 year maintenance fee had not been paid.

21. During my employment, the firm was handling very few reissue and reexamination proceedings. I am informed that reissue and reexamination cases represented less than about 2% of the patent cases being handled by the firm. In addition, at the time the first docketing error was noted, the only apparent error was the year that the fee was due.

22. The client returned the reminder form to the firm on August 20, 2004, with instructions to pay the 7.5 year maintenance fee. A copy of the form returned by the client is attached hereto as Exhibit D. The client's instructions were noted in the docket record for the subject patent. (See Exhibit C, Box 1; the boxes were added for purposes of identification.)

23. As noted above, it was standard practice at the time of the above error to reconcile and resolve anomalies, inconsistencies, questions and the like prior to taking action, and before any due date was cleared from the docket. However, the Docketing Department was not aware of the error in non-payment of the 3.5 year maintenance fee.

24. Authorization to charge the 7.5 year maintenance fee to Deposit Account No. 23-2185 was provided to the PTO on August 27, 2004, and receipt of said authorization was acknowledged by the PTO. Funds sufficient to process the 7.5 year maintenance fee were available in the deposit account on August 27, 2004. A copy of the authorization and acknowledgement is attached as Exhibit E. Transmittal of payment was noted in the docket record for the patent (see Exhibit C, Box 2).

25. The 7.5 year maintenance fee was timely paid with sufficient funds in the deposit account. And, the confirmation postcard (Exhibit E, 2nd page) confirmed that the Office received the documents. Thus, in accordance with the firm's procedures, maintenance fee statements and deposit account activity for the subject patent was not monitored. It was believed that the Office accepted payment of the 7.5 year maintenance fee and that the patent remained in force. A letter dated August 27, 2004, and addressed to the patent owner acknowledged receipt of the instructions to pay the 7.5 year maintenance fee and indicated that the fee had been paid or would be paid by the due date. A copy of this letter is attached hereto as Exhibit F.

26. No Notice of Non-Acceptance of Patent Maintenance Fee was received by the firm, otherwise it would appear in the docket record (Exhibit C).

27. I understand that the PTO states that it would have been reasonable to expect that the Petitioner might routinely check the status of the patent and that the maintenance fee was accepted by the PTO. It is my opinion, however, that it probably just did not occur to that person to check on the status of the 3.5 year maintenance fee. In hindsight, the PTO may think it would have been reasonable to check on the status of the 3.5 year maintenance fee at that time. However, it is likely that the error was corrected sometime from March-June 18, 2004, which is when reminders would be sent to the client for the improperly-docketed 3.5 year deadline. It is important to keep in mind that the docketed date (i.e., Sept. 25, 2004) was correct. It was only the notation that it was for the 3.5 year fee, rather than the 7.5 year fee, which was incorrect. Thus, at the time the error was discovered, it would have been natural to assume that the only error was the notation of which fee was due, especially since the date itself (Sept. 25, 2004) was correct.

28. Given such an unusual situation (of an improperly docketed reissue patent), it is certainly understandable that the person would not have recognized at that time, that the earlier fee had not been paid. In addition, the PTO confirmed receipt of the 7.5 year fee (see Exhibit E), and the firm never received any notice from the PTO that the 7.5 year fee was not accepted. Thus, the fact that these two clerical errors were made does not alter my opinion that the firm acted as a reasonable and product person would treat its most important business, and further that it exercised due care and had a reliable and trustworthy system in place to play maintenance fees for its most important business, including for the present patent.

Dated: _____

Respectfully,

By _____
Huedell George

Weissman, Peter

From: Weissman, Peter
Sent: Friday, April 09, 2010 1:42 PM
To: 'mrdellgeorge@gmail.com'
Subject: FW: Exhibits to George Statement.PDF;Statement of Huedell George.DOC
Attachments: Exhibits to George Statement.PDF^; Statement of Huedell George.DOC^



Dell,

I just left you a voice message. Kindly see attached. If it looks okay, please sign the statement and fax or mail it back to me.

Thank you,
 Peter

Peter S. Weissman | Blank Rome LLP
 Watergate 600 New Hampshire Avenue, NW | Washington, DC 20037
 Phone: 202.772.5805 | Fax: 202.572.1405 | Email: Weissman@BlankRome.com

From: Weissman, Peter
Sent: Monday, March 08, 2010 12:21 PM
To: 'mrdellgeorge@gmail.com'
Subject: FW: Exhibits to George Statement.PDF;Statement of Huedell George.DOC

Dell,

Let me know if you've had a chance to look this over. If it is okay, please sign and fax or mail to me. If you have changed, please give me a call to discuss.

Thank you,
 Peter

Peter S. Weissman | Blank Rome LLP
 Watergate 600 New Hampshire Avenue, NW | Washington, DC 20037
 Phone: 202.772.5805 | Fax: 202.572.1405 | Email: Weissman@BlankRome.com

From: Weissman, Peter
Sent: Thursday, February 25, 2010 4:55 PM
To: 'mrdellgeorge@gmail.com'
Subject: Exhibits to George Statement.PDF;Statement of Huedell George.DOC

Dell,

Thank you again for the call last week. As discussed, attached is a draft statement for you to review. Let me know if something is not accurate, or if you don't feel that you have sufficient knowledge to make certain statements. I'm available to discuss whenever you have a chance.

4/9/2010

Thanks,
Peter

Peter S. Weissman | Blank Rome LLP

Watergate 600 New Hampshire Avenue, NW | Washington, DC 20037

Phone: 202.772.5805 | Fax: 202.572.1405 | Email: Weissman@BlankRome.com

4/9/2010